



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 18

Daniel S. Polley, Esq.
Malin, Haley & DiMaggio, P.A.
1936 South Andrews Avenue
Ft. Lauderdale, Florida 33316

COPY MAILED

JAN 07 2004

OFFICE OF PETITIONS

In re Application of :
Robert M. CARMICHAEL :
Application No. 09/730,116 : DECISION ON PETITION
Filed: December 5, 2000 :
Attorney Docket No. 9297.6817 :
:

This is a decision on the petition, filed November 15, 2002, requesting (1) pursuant to 37 CFR §§1.181-1.183 "for permission to herein claim priority to U.S. Application No. 09/628,836 ('836), and (2) to be listed as a co-inventor in the '836 application.

The petition considered under 37 CFR 1.181, or 1.182, or 1.183, in this application is DISMISSED.

The petition to amend the inventorship in the '836 is dismissed as immaterial to the above-identified application.

BACKGROUND

The instant application was filed on December 5, 2000 naming Robert M. Carmichael as the sole inventor.

The instant application is asserted to be related to application no. 09/628,836, filed July 31, 2000, the express abandonment of which was recognized by the USPTO on September 19, 2001. The application named Sergio Angelini as the sole inventor. The assignee of record is Johnson Outdoors Inc.

The instant application is also asserted to be related to application no. 09/916,414, filed July 26, 2001, now US Pat. No. 6,527,480, issued on March 4, 2003. The application named Sergio Angelini and Robert Carmichael as joint inventors. The assignee of record is Johnson Outdoors Inc.

STATUTE AND REGULATION

35 U.S.C. 120 provides, in part:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application, shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application, and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

37 CFR 1.78(a)(1) states, in part:

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112.

37 CFR 1.78(a)(2) states, in part:

(2)(I) Except for a continued prosecution application filed under §1.53(d), any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see §1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(I) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (A) An application for a design patent;
- (B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or
- (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

37 CFR 1.78(a)(3) states:

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C.

120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (I) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
- (ii) The surcharge set forth in § 1.17(t); and
- (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

37 CFR 1.48(a) states:

(a) *Nonprovisional application after oath /declaration filed.* If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. If the nonprovisional application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or 1.47;
- (4) The processing fee set forth in § 1.17(l); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 CFR 1.182 *Questions not specifically provided for.*

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in §1.17(h).

§ 1.183 *Suspension of rules.*

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(h).

OPINION

Taking the latter request first, any request to amend the inventive entity of the '836 application must be presented as a separate paper specifically captioned for that application. See 37 CFR 1.4(b), (c). In other words, consideration of the merits of the instant petition is limited to the extent that it applies to the instant application, for which it is captioned.¹

¹ Petitioner is advised that the USPTO will consider a petition under 37 CFR 1.48 to amend the inventorship of an abandoned application if that petition, expressly captioned for that application is also accompanied by a petition under 37 CFR 1.182 likewise captioned for the abandoned application, and the appropriate fees. Before presenting any such petitions in the '836 application, petitioner should consider that any forthcoming petition under 37 CFR 1.48 would necessarily require the consent of the assignee of the entire interest of the originally named inventor(s), and that petitioner has acknowledged that the assignee of the '836 application chose to correct the inventive entity by filing a continuation application in lieu of amending the inventive entity of the '836 application under the provisions of 37 CFR 1.48.

As to consideration of the petition under 37 CFR 1.181, it is noted that the examiner has instituted and maintained, *inter alia*, a rejection of the claims under 35 U.S.C. 102(f) over the '836 application, which rejection is grounded on the fact that there is no common inventor between the '836 application and the instant application. See e.g., Office action of January 31, 2003, ¶ 5. It is noted that, by its terms, 37 CFR 1.181 only permits review, on petition, of matters that are not also subject to review on appeal. See 37 CFR 1.181(a). Since any forthcoming review of that rejection is committed by statute and regulation to the Board of Patent Appeals and Interferences, the issue will not be further considered on petition under 37 CFR 1.181. In this regard, it is the long-established policy of the Patent and Trademark Office to maintain the line of demarcation between matters which are appealable, and those which are petitionable. MPEP 1201. It is well settled that the Commissioner will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board of Patent Appeals and Interferences. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971). Accordingly, the petition considered under 37 CFR 1.181 is dismissed.

As to consideration of the petition under 37 CFR 1.182, that regulation, by its terms, only applies where no other regulation speaks to the issue. Since 37 CFR 1.78 specifically sets forth the conditions of whether, and how, benefit of an earlier non provisional application may be claimed, then 37 CFR 1.182 is not properly invoked in this instance. 37 CFR 1.182 applies only where other rules are inapplicable. Furthermore, 37 CFR 1.78(a)(1) requires *inter alia*; that "each prior-filed application [of which benefit is sought] must name as an inventor at least one inventor named in the later- filed application." Petitioner admits that he is not named as an inventor in the '836 application, and inspection of this application fails to reveal that the inventor of the '836 application is also named as an inventor herein. Thus, there simply is no common inventor between the '836 and instant application. But see 37 CFR 1.78. 37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures. See Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (1903). As such, the petition considered under 37 CFR 1.182 is likewise dismissed.

As to consideration of the petition under 37 CFR 1.183, that regulation, by its terms, may not be invoked to waive any requirement of the rules that is also a requirement of the patent statute. However, 35 U.S.C. § 120 conditions a claim for benefit of a prior application, *inter alia*, on there herein being named "an inventor or inventors named in the previously filed application." While, as noted above, that requirement of the statute is admittedly lacking herein, 37 CFR 1.183

simply cannot be invoked--or properly applied-- to override that requirement of law as such is beyond the authority, much less the discretion, of the USPTO. Since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute. See A.F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977). That is, the USPTO simply lacks the authority or the discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A.F. Stoddard v. Dann, *Id.* Accordingly, the petition considered under 37 CFR 1.183 is likewise dismissed.

This application is being forwarded to Technology Center Art Unit 3617 for examination in due course.

Any inquiries concerning this decision may be directed to B. Dayoan at (703) 308-3865 or, in her absence, to the undersigned at (703) 305-1820.



Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy